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OFFICE OF PETITIONS

In re Application of :
Elmer M. Johnson et al. :
Application No. 10/604,570 : DECISION ON PETITION
Filed: July 30, 2003 : UNDER 37 C.F.R. § 1.181
Attorney Docket No.: 1111.03001 :
Title: DOOR SECURITY APPARATUS :

This is a decision on the petition filed on July 3, 2007, pursuant to 37 C.F.R. § 1.181, requesting that the holding of abandonment in the above-identified application be withdrawn.

BACKGROUND

A Notice of Allowance and Issue Fee Due (first notice) was mailed on December 1, 2006, which set a three-month period for the submission of the issue and publication fees. No extensions of time are permitted for transmitting issue or publication fees¹.

On February 1, 2007, the Office mailed a "Notice to File Corrected Application Papers - Notice of Allowance Mailed" (second notice), which indicated that corrected drawings were required. The notice set a two-month non-extendable period for response.

As such, the Office set **two concurrent deadlines**: both notices indicated that unless Petitioner submitted the issue and publication fees by March 1, 2007 and the corrected drawings by April 1, 2007, the present application would go abandoned. **Each of these notices set forth a separate requirement, and each set a period for response that ran independently of the other.**

¹ See MPEP §710.02(e).

Corrected drawings were received on March 31, 2007. No response to the first notice was received, and accordingly, the above-identified application became abandoned on March 2, 2007. A Notice of Abandonment was mailed on May 3, 2007.

RELEVANT LAW AND PORTIONS OF THE C.F.R.

35 U.S.C. 151 Issue of patent.

If it appears that applicant is entitled to a patent under the law, a written notice of allowance of the application shall be given or mailed to the applicant. The notice shall specify a sum, constituting the issue fee or a portion thereof, which shall be paid within three months thereafter.

Upon payment of this sum the patent shall issue, but if payment is not timely made, the application shall be regarded as abandoned.

Any remaining balance of the issue fee shall be paid within three months from the sending of a notice thereof, and, if not paid, the patent shall lapse at the termination of this three-month period. In calculating the amount of a remaining balance, charges for a page or less may be disregarded.

If any payment required by this section is not timely made, but is submitted with the fee for delayed payment and the delay in payment is shown to have been unavoidable, it may be accepted by the Director as though no abandonment or lapse had ever occurred.

37 C.F.R. § 1.134: Time period for reply to an Office action.

An Office action will notify the applicant of any non-statutory or shortened statutory time period set for reply to an Office action. Unless the applicant is notified in writing that a reply is required in less than six months, a maximum period of six months is allowed.

37 C.F.R. § 1.135: Abandonment for failure to reply within time period.

- (a) If an applicant of a patent application fails to reply within the time period provided under § 1.134 and § 1.136, the application will become abandoned unless an Office action indicates otherwise.
- (b) Prosecution of an application to save it from abandonment pursuant to paragraph (a) of this section must include such complete and proper reply as the condition of the application may require. The admission of, or refusal to admit, any amendment after final rejection or any amendment not responsive to the last action, or any related proceedings, will not operate to save the application from abandonment.
- (c) When reply by the applicant is a bona fide attempt to advance the application to final action, and is substantially a complete reply to the non-final Office action, but consideration of some matter or compliance with some requirement has been inadvertently omitted, applicant may be given a new time period for reply under § 1.134 to supply the omission.

ANALYSIS

With the present petition, Petitioner has submitted both the issue and publication fees, and has asserted that he was "under the impression" that the second notice "put a stay on the pending" first notice and that a subsequent Notice of Allowability and Issue Fee Due would be issued at a later date².

This understanding was incorrect. As set forth above, each of these notices set forth a separate requirement, and each set a period for response that ran independently of the other.

Petitioner failed to submit the issue and publication fees in a timely manner, and as such, the present application went abandoned by operation of law, pursuant to the law and regulations cited above.

As such, Petitioner has failed to establish that the holding of abandonment should be withdrawn, and this petition must be **DISMISSED**.

ANALYSIS

Any reply to this decision must be submitted within **TWO MONTHS** from the mail date of this decision. Extensions of time under 37 C.F.R. § 1.136(a) are permitted.

The reply should include a cover letter entitled "Renewed Petition Under 37 C.F.R. § 1.181(a)." This is not a final agency action within the meaning of 5 U.S.C § 704.

Alternatively, Petitioner may wish to consider filing a petition under 37 C.F.R. §§ 1.137(a) and/or (b).

Any submission in response to this decision should indicate in a prominent manner that the attorney handling this matter is Paul Shanoski, and may be submitted by mail³, hand-delivery⁴, or facsimile⁵. Registered users of EFS-Web may alternatively submit a response to this decision via EFS-Web⁶.

If responding by mail, Petitioner is advised not to place the undersigned's name on the envelope. Only the information that

2 Petition, pages 1-2. See also page 3.

3 Mail Stop Petition, Commissioner for Patents, United States Patent and Trademark Office, P.O. Box 1450, Alexandria, VA, 22313-1450.

4 Customer Window, Randolph Building, 401 Dulaney Street, Alexandria, VA, 22314.

5 (571) 273-8300- please note this is a central facsimile number.

6 <https://sportal.uspto.gov/authenticate/authenticateuserlocalepf.html>

appears in the footnote should be included - adding anything else to the address will delay the delivery of the response to the undersigned.

Telephone inquiries regarding *this decision* should be directed to the undersigned at (571) 272-3225⁷. All other inquiries concerning examination procedures or status of the application should be directed to the Technology Center.



Paul Shanoski
Senior Attorney
Office of Petitions
United States Patent and Trademark Office

⁷ Petitioner will note that all practice before the Office should be in writing, and the action of the Office will be based exclusively on the written record in the Office. See 37 C.F.R. § 1.2. As such, Petitioner is reminded that no telephone discussion may be controlling or considered authority for Petitioner's further action(s).